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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,412	01/25/2002	Jean Woloszko	G-3	1345

21394 7590 04/24/2003  
ARTROCARE CORPORATION  
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EXAMINER
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COHEN, LEE S

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 04/24/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/057,412	WOLOSZKO ET AL.
Examiner	Art Unit	
Lee S. Cohen	3739	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
   
 If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
   
 If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
   
 Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   
 Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_\_.
   
 2a) This action is FINAL.                    2b) This action is non-final.
   
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-120 is/are pending in the application.
   
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
   
 5) Claim(s) \_\_\_\_\_ is/are allowed.
   
 6) Claim(s) \_\_\_\_\_ is/are rejected.
   
 7) Claim(s) \_\_\_\_\_ is/are objected to.
   
 8) Claim(s) 1-120 are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.
   
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
   
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   
 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
   
     If approved, corrected drawings are required in reply to this Office action.
   
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   
     a) All b) Some \* c) None of:
   
         1. Certified copies of the priority documents have been received.
   
         2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
   
         3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   
     \* See the attached detailed Office action for a list of the certified copies not received.
   
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
   
     a) The translation of the foreign language provisional application has been received.
   
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)
   
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
   
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
   
 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
   
 5) Notice of Informal Patent Application (PTO-152)
   
 6) Other: \_\_\_\_\_.

*Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19 and 113-120, drawn to a return electrode, classified in class 606, subclass 32.
- II. Claims 20-112, drawn to a probe and method, classified in class 606, subclass 41.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombination and combination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the return electrode is broadly claimed in the combination claims. The subcombination has separate utility such as use in an electrosurgical procedure using a separate active electrode.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Upon the election of Group II supra, the following election of species is required:

This application contains claims directed to the following patentably distinct species of the claimed invention: I-VII which relate to the embodiments disclosed in Figures 48, 50, 51, 52, 56, 58, and 61, respectively.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are deemed to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

Art Unit: 3739

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee S. Cohen whose telephone number is 703-308-2998. The examiner can normally be reached on Monday-Friday, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Lee S. Cohen  
Primary Examiner  
Art Unit 3739

LSC  
April 23, 2003